

REMARKS

Upon entry of the present amendment, claims 1-24 will be pending in the application. Of these, claims 16-24 have been withdrawn from consideration. Claims 1 and 4 have been amended in accordance with the requirements of U.S. patent practice. In particular, the phrase “complete or near-complete” has been deleted from claim 1 to overcome an indefiniteness rejection. In claim 4, the limitation “from 50 μm thick” has been replaced with “from 1 to 50 μm thick”. Support is found at least on p. 8, ll. 9-10 of the application as filed.

Any amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

- Rejection of claims 1 and 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The phrase “complete or near-complete” has been deleted from claim 1. With respect to claim 4, the “from 50 μm thick” has been replaced with “from 1 to 50 μm thick”. Applicants submit that these amendments address the Examiner's rejections. Reconsideration and removal of the U.S.C. 112, second paragraph rejection is respectfully requested.

2. **Rejection of claims 1-3 and 5-8 under 35 U.S.C. 103(a) as being obvious over JP2004-175813 to Takano. The English language equivalent, U.S. Patent No. 7,485,674 (hereafter "Takano"), was used for the citation of column and line.**

With respect to claim 1, the PTO alleges:

The reference differs from Applicant's recitations of claims by not disclosing identical ranges (the ratio of the diameter to thickness is in the range of 100-10). However, the reference discloses "overlapping" ranges (0.02-10000), and overlapping ranges have been held to establish *prima facie* obviousness (MPEP 2144.05).

(*Office Action of 7/23/09, p. 4, first full par.*)

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. Takano does not teach or suggest all the limitations of claim 1. For an obviousness rejection to be proper, the PTO must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a *prima facie* case of obviousness requires that all limitations of the claim be taught or suggested by the prior art. See, e.g., *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

Takano discloses a powder coating composition comprising a "powder coating particle including thermosetting resin powder, and adhesive binder, and a *flake pigment bound to a surface of the thermosetting resin powder by means of the binder.*" (Takano, claim 1 and col. 3, ll. 51-55). Claim 1 of the present application requires, on the other hand, that component (B) is "*free from leaflet-shaped effect pigments*". Since Takano does not teach or suggest all the limitations of claim 1, and claims 2, 3, and 5-8 which depend therefrom, these claims are not obvious over Takano. Therefore, reconsideration and removal of this obviousness rejection is respectfully requested in view of the foregoing remarks.

3. **Rejection of claims 1 and 13-14 under 35 U.S.C. 103(a) as being obvious over German Publication No. DE 100 27 293 A 1 to Lassmann et al. Page and paragraph numbers were taken from the EPO machine translation of Lassmann (hereafter "Lassmann").**

In particular, the PTO alleges:

Regarding claims 1, and 13, DE '293 discloses a pigment composition containing a platelet aluminum effect pigment coated with polymer and a transparent powdery coating. The aluminum pigment's property has a ratio of thickness to diameter in a range off 0.02-0.002 (evidence by the search report). The polymer coating is a leaflet-shape particle. The aluminum platelet effect pigment is coated on the polymer-the leaflet-shape particle. The effect pigment has an aspect ratio of $1/0.02=50$ to $1/0.002=500$ (i.e. this reads on leaflet-shaped). The transparent particles can be resin or titanium oxide. (Page 3 paragraph 5, page 4 paragraph 10)

(Office Action of 7/23/09, par. spanning pp. 4 and 5)

Applicants greatly appreciate the detailed basis of rejection, but must disagree. Applicants respectfully request the PTO to supply the "search report" referred to in this rejection. Applicants submit that search reports are generally not valid prior art references unless they were available to the general public at the appropriate time.

After a careful reading of Lassmann, Applicants can not find any disclosure of an aluminum pigment having a ratio of thickness to diameter of 0.02-0.002, and respectfully request that if there is such a disclosure, that the PTO identifies the relevant passage by page and par. number.

With respect to the polymer coating of the aluminum pigment, the particles of present claims 1 and 13 are not coated, which differentiates them from the aluminum pigments taught by Lassmann.

With respect to the transparency of the particles, par. 5 of p. 3 of Lassmann teaches that the polymers that make up the *coating* of the aluminum pigment particles are transparent, *not the particles themselves*. Therefore the paragraph does not teach or suggest component (B) of claim 1.

With respect to the disclosure of titanium dioxide, par. 10 of p. 4 of Lassmann does not teach or suggest that the titanium dioxide is a transparent grade. Taking the paragraph as a whole, the skilled person will conclude that it teaches opaque, not transparent, pigments. Nor does the cited paragraph teach or suggest that the ratio of diameter to thickness for the pigment particles is less than 10:1 as required by component (B) of claim 1.

For all of these reasons, Applicants submit that claims 1 and 13 are not obvious over Lassmann. Therefore, reconsideration and removal of this obviousness rejection is respectfully requested.

4. **Rejection of claims 1-8 and 12-14 under 35 U.S.C. 103(a) as being obvious over U.S. Publication No. 2004/0191198 A1 to Hochstein et al. (hereafter "Hochstein"), in view of International Publication No. 02/090448 to Anselmann et al. The English language equivalent, U.S. Patent No. 7,226,503 (hereafter "Anselmann"), was used for the citation of column and line.**

In particular, the PTO alleges:

The component B comprises of spherical colorant or filler. The component B can be a transparent substrate. But they are silent about the effect pigment aspect ratio as applicant set forth in claim 1.

(Office Action of 7/23/09, p. 6, first par.)

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. After a careful reading of Hochstein, Applicants can not find any teaching or suggestion that component B is transparent as required by claim 1.

With respect to claim 14, the materials corresponding component B of Hochstein can not be cured by any means, physically, thermally, or with actinic radiation. Since the materials of component B of Hochstein can not be cured by any means, Hochstein does not teach or suggest all the limitations of claim 14.

For these reasons, Applicants submit that claim 1, and claims 2-7 and 12-14 which depend therefrom, are not obvious over Hochstein in view of Anselmann. Therefore, reconsideration and removal of this obviousness rejection is respectfully requested.

5. **Rejection of claims 9-11 under 35 U.S.C. 103(a) as being obvious over US 2004/0191198 A1 to Hochstein et al. (hereafter "Hochstein"), in view of International Publication No. WO 02/090448 to Anselmann et al. and further in view of U.S. Patent No. 5,565,025 to Schraml-Marth (hereafter "Schraml-Marth").**

In particular, the PTO alleges:

Regarding claims 9-11, combined teaching of Hochstein et al. and WO'448 discloses a composition as applicant sets forth in claim 1. It is noted that claims 9 and 11 are a product-by-process claims. . . . Anselmann et al. disclose that the coating layer thickness on the glass flake is up to 1 micron. But they are silent that the glass flake comprises a transparent layer as applicant set forth in claims 9-11.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use transparent titanium oxide in the composition, motivated by the fact that Schraml-Marth, also drawn to pigment, discloses that transparent titanium oxide has good UV absorbing property (col. 2, lines 12-17).

(Office Action of 7/23/09, p. 7, last par. to p. 8, first par.)

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. As set forth in Section 4 of this paper, the combination of Hochstein and Anselmann does not teach or suggest that component B is transparent as required by claims 9-11 (based on their dependence from claim 1).

With respect to transparent titanium dioxide, Schraml-Marth teaches that when in the form of discrete particles, transparent titanium dioxide particles are less than 100 nm in diameter. Schraml-Marth is silent on whether a titanium dioxide coating disposed on another particle, e.g. a glass flake, is transparent or not. However, given that the titanium dioxide coated glass flakes of Hochstein are 10-80 microns (i.e. 10,000-80,000 nm), the particles are far from meeting the requirement for transparency of less than 100 nm. Moreover, Applicants submit that a titanium dioxide coating of 1 micron as disclosed by Hochstein can not be transparent at least because it exceeds the upper limit for transparency of 100 nm as taught by Schraml-Marth.

For these reasons, Applicants submit that claims 9-11 are not obvious over Hochstein in view of Anselmann and Schraml-Marth. Therefore, reconsideration and removal of this obviousness rejection is respectfully requested.

6. **Rejection of claims 1-15 under 35 U.S.C. 103(a) as being obvious over U.S. Publication No. 2003/0008963 to Hashizume (hereafter "Hashizume") in view of U.S. Patent No. 6,017,989 to Malm et al. (hereafter "Malm").**

In particular, the PTO alleges:

Regarding claims 1, 5 and 12-13, Hashizume disclose that a composition comprises aluminum flake pigment (effect pigment) and rounded resin particles

can be used in auto industry (abstract, [0001]). Example of the powder resin includes polyester or acrylic resin resins ([0008]). The effect pigment has an aspect ratio of 5-100 [0013]. But they are silent about the resin is transparent.

(Office Action of 7/23/09, p. 7, last par. to p. 8, first par.)

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. Hashizume discloses a colored metallic powder coating composition comprising a colored metallic flake *adhered on each particle surface of a resin powder* (Hashizume claim 1). Moreover, Hashizume teaches in par. 6:

Characteristic of the present invention is to adhere a colored metallic flake onto each particle surface of a resin powder. By adhering a colored metallic flake onto each particle surface of a resin powder, a powder coated paint film having a high saturation (saturation value ≥ 10) and an excellent metallic sensation can be obtained with a high adhesion efficiency.

Claim 1 of the present application requires, on the other hand, that component (B) is “free from leaflet-shaped effect pigments”. Since Hashizume does not teach or suggest all the limitations of claim 1 and claims 2-15, which depend therefrom, Applicants submit that the claims are not obvious over Hashizume. Therefore, reconsideration and removal of this obviousness rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/
Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

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CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
Wyandotte, MI 48192
Customer No. 26922

MEG/DJJ